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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,398	03/30/2004	Seth Goldberg	GBAND-0003	1750

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,398

Applicant(s)

GOLDBERG ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/30/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: in line 8, "a image" should be replaced with "an image". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 1 recites the limitation "the display surface" in line 11. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 1 recites the limitation "the edge" in line 18. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 2 recites the limitation "the back surface" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goins (2,716,390) in view of Alden (5,577,459).

Goins discloses a bookmark comprising an elastic band (1 – flexible loop) having a selected width and thickness and being expandable from a relaxed condition to a stretched condition when placed over a page of a book and over an outside cover of the book (as seen in figure 1); a slider (2) mounted on the elastic band having an outer surface facing away from the elastic band and an inner surface facing toward the elastic band (as seen in figures 1 and 2); and an image support area (the examiner considers the image support area to be located any where in the outer surface of the pointer/slider), the image support area having a width greater than the width of the elastic band (as seen in figure 1).

Goins discloses the claimed invention except for the image support area having an image thereon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the image support area, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of bookmark does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel

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and unobvious functional relationship between the printed matter and the substrate, which is required for patentability.

Furthermore, Alden discloses a bookmark having a slider (1) having an image support area with an image thereon ("Paragraph Last Read").

Goins discloses the claimed invention except for first and second wings extending from the display surface having flanges which are folded to form first and second tubes and first and second gaps in the first and second tubes sufficiently large to receive the edge of the elastic band.

Alden discloses a bookmark comprising a body (2) and a sliding collar (1) having an aperture (3). The collar includes first and second wings extending from the display surface of the collar having flanges which are folded to form first and second tubes and first and second gaps in the first and second tubes sufficiently large to receive the body of the bookmark (as seen in figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the slider with first and second wings forming first and second tubes, as taught by Alden, to provide a secure, frictional engagement between the slider and the bookmark body.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goins in view of Alden and further in view of Porto (5,408,950).

Goins, as modified by Alden, discloses the claimed invention except for the slider having a sticker attached thereto, the sticker having an image on the front surface and adhesive on the back surface.

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Porto discloses that it is known to provide a bookmark with a sticker by disclosing a bookmark having a display device comprising a head portion (12) including a flat display head (16) having a pressure-sensitive adhesive coating (18) applied to some or all of the back surface (20) of the display head (16). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the slider with a sticker, as taught by Porto, to display messages, greeting, business logos and cards, photographs, etc., thereon." (see column 1, lines 32-44)

Allowable Subject Matter

9. Claims 3-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose bookmarks.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 15, 2005

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER